

REMARKS

By the foregoing amendment, claim 6 has been amended to render the claim language more definite. Applicants note that the amendment adds no new matter. Entry of the amendment is respectfully requested.

RESPONSE TO THE OFFICE ACTION**Claim Rejections under 35 U.S.C. § 112**

The Office Action rejects claim 6 under 35 U.S.C. § 112 as allegedly being indefinite for failing to comply with the definiteness requirement. In particular, the Action asserts that the phrase “to the composition” is unclear.

In response, Applicants submit the foregoing amendment to render claim 6 more definite. In view of the amendment, Applicants respectfully request withdrawal of the rejection.

**Art-Based Claim Rejections (35 U.S.C. §§ 102(b) and 103(a))**

The Action rejects claims 1-3, 5, and 8 under 35 U.S.C. § 102(b) as allegedly being anticipated by Trumbo et al. (Journal of Nutrition (1988), 118 (2), pp. 170-175). The Office Action asserts that Trumbo et al. anticipates claims 1-3 and 5 by allegedly disclosing a compound that falls within the scope of these claims. As for claim 8, the Office Action asserts that although Trumbo et al. does not disclose cosmetics, a composition also anticipates the intended use of such composition.

The Office Action raises the following 35 U.S.C. § 103(a) rejections:

- (a) Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogata et al. (*The Journal of Vitaminology*, 15, pp. 160-166 (1969)) in view of Trumbo et al.;
- (b) Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Trumbo et al.; and
- (c) Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2002-265316 in combination with Trumbo et al.

The art-based rejections are respectfully traversed. As previously presented to the Examiner in the response filed March 7, 2008, Trumbo et al. discloses 5'-O-( $\beta$ -D-Glucopyranosyl)pyridoxine (CAS No. 63245-12-5). This compound does not fall within the scope of Applicants' claims because it has a glycosyl moiety at the 5'-position, whereas Applicants require that it be the 3-position. Additionally, there is nothing in Trumbo et al., and the Office has failed to point to any teaching, that would give reason to a person of ordinary skill in the art to modify Trumbo et al.'s compound to arrive at the present invention. For at least these reasons, Applicants submit that Trumbo et al. fails to disclose or suggest Applicants' claimed invention. Applicants note that the Examiner also cites two more documents that allegedly disclose Applicants' compounds (Office Action, page 11, Exhibits A and B). Upon review of these additional documents, Applicants respectfully submit that these documents also fail to disclose Applicants' compounds.

The Action maintains that the Chemical Abstract for Trumbo et al. constitutes a separate citable disclosure (Office Action, page 11). Applicants disagree.

Applicants respectfully submit that the Chemical Abstract cited by the Examiner does not constitute an anticipating disclosure. As the Office knows, any document cited in a rejection must be enabling, i.e., the document must put the public in possession of the claimed invention. Applicants respectfully submit that none of the journal publications that the Examiner cited will put the public in possession of the presently claimed compounds.

Further, Applicants note that the Chemical Abstract cited by the Office does not put the public in possession of Applicants' compound. It fails to teach how to make Applicants' compound and any other relevant information. Applicants respectfully submit that the compound disclosed in the Chemical Abstract can at best be characterized as a misrepresentation similar to a typographical error. Applicants note that for such erroneous disclosure, the courts have given clear guidance how to evaluate such misrepresentations.

In *In re Yale* (434 F.2d 666, 168 U.S.P.Q 46 (C.C.P.A. 1970)), the applicant sought a patent on the compound 3-bromo-3-chloro-1,1,1,2,2-pentafluoropropane, which has the formula CF<sub>3</sub>CF<sub>2</sub>CHClBr. A publication by Clements reported the results of certain research and listed CF<sub>3</sub>CF<sub>2</sub>CHClBr as one of nine compounds plotted on a graph. The applicant established that the listing of the compound was a typographical error that would be apparent to one of ordinary skill in the art. The Court of Customs and Patent Appeals held that the Clements article did not adequately disclose the claimed compound and stated that “[s]ince it is an obvious error, it cannot be said that one of ordinary skill in

the art would do anything more than mentally disregard [it] or mentally substitute [the intended formula] in its place" (434 F.2d at 668-669).

As in *In re Yale*, Applicants respectfully submit that one of ordinary skill in the art upon reviewing the Chemical Abstract cited by the Office would *mentally disregard* or *mentally substitute* the erroneous compound.

With respect to the obviousness rejections, Applicants respectfully submit that none of the secondary references cures the deficiency of Trumbo et al., i.e., none discloses any of the compounds falling within the scope of the present claim. Furthermore, Applicants submit that in the absence of a disclosure of at least one compound that falls within the scope of Applicants' claimed invention, there can be no teaching or suggestion of a method how to prepare such compound as claimed by present claim 4.

Applicants also respectfully submit that there can be no *prima facie case* of obviousness for a composition that includes at least one of Applicants' claimed compounds. Even assuming – *arguendo* – that one of ordinary skill would rely on Trumbo et al., Applicants submit that there is no teaching or suggestion or other reason in Trumbo et al. and/or any of the secondary references that would prompt the skilled artisan to modify the compounds disclosed therein to arrive at compositions that comprise compounds having the stability as recited claim 7, or any of the properties listed in claim 9, or the whitening agent as recited in claim 10. For this reason, Applicants submit that Trumbo et al. in combination with any of the cited secondary references fails to render claims 4, 7, 9, and 10 obvious.

Applicants submit that none of the documents cited under the obviousness rejection, either alone or in combination, renders the rejected claims obvious. Applicants respectfully request withdrawal of these rejections.

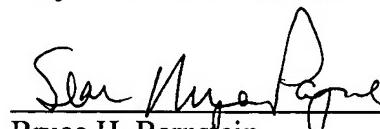
#### CONCLUSION

Applicants submit that Trumbo et al. or any Chemical Abstracts cited by the Examiner fail to anticipate or render obvious any compound that falls within the scope of the present claims. Applicants also submit that the Chemical Abstract relied upon by the Office fails to put the public in possession of Applicants claimed compounds. Withdrawal of all art-based rejections is respectfully requested.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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